UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,252	08/28/2001	David Kingsley Clark	AUS9-2001-0723-US1	6028

40412   7590   02/27/2009

IBM CORPORATION- AUSTIN (JVL)
C/O VAN LEEUWEN & VAN LEEUWEN
PO BOX 90609
AUSTIN, TX 78709-0609

EXAMINER
STERRETT, JONATHAN G

ART UNIT	PAPER NUMBER
3623	

MAIL DATE	DELIVERY MODE
02/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

1   UNITED STATES PATENT AND TRADEMARK OFFICE
2   _____
3
4   BEFORE THE BOARD OF PATENT APPEALS
5   AND INTERFERENCES
6   _____
7
8   *Ex parte* DAVID KINGSLEY CLARK, THEODORE JACK LONDON
9   SHRADER, and JULIE LOUISE GILBREATH
10   _____
11
12   Appeal 2009-0126
13   Application 09/941,252
14   Technology Center 3600
15   _____
16
17   Decided:[1] February 27, 2009
18   _____
19
20   *Before* ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
21   MOHANTY, *Administrative Patent Judges.*
22
23   FETTING, *Administrative Patent Judge.*
24
25
26   DECISION ON APPEAL
27
28   STATEMENT OF THE CASE

---

[1] The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1   David Kingsley Clark, Theodore Jack London Shrader, and Julie

2 Louise Gilbreath (Appellants) seek review under 35 U.S.C. § 134 of a non-

3 final rejection of claims 1, 3-9, 11-17, and 19-24, the only claims pending in

4 the application on appeal.

5   We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)

6 (2002).

7

8   We REVERSE.

9   The Appellants invented an anonymous mail forwarding architecture

10 that provides for anonymous voting (Specification Page 3, lines 1-5).

11   An understanding of the invention can be derived from a reading of

12 exemplary claims 1, 3, and 6, which are reproduced below [bracketed matter

13 and some paragraphing added].

14   1. A method for processing an electronic voting message, said

15   method comprising:

16   [1]   compiling a voter data list that includes a plurality of
17   authorized voters;
18   [2]   sending the voter data list to a mail forwarding service,
19   wherein the mail forwarding service sends one or more vote
20   requests to one or more of the plurality of authorized voters;
21   [3]   receiving the electronic voting message from a client;
22   [4]   determining, based on the voter data list, whether the
23   client is authorized to vote;
24   [5]   in response to determining that the client is authorized to
25   vote, performing the following:
26   [a]   removing an identity of the client from the
27   electronic voting message, wherein the removing results
28   in an anonymous message; and
29   [b]   identifying one or more votes in the anonymous
30   message; and
31   [6]   in response to determining that the client is not
32   authorized to vote, disregarding the electronic voting message.

3. The method as described in claim 1 further comprising:
    sending a confirmation message to the client, the
confirmation message including a summary of the
determination.

6.   The method as described in claim 1 further comprising:
    modifying a total number of votes, the modifying further
including:
    adding the one or more votes to the total number of
votes.

This appeal arises from the Examiner's Non-Final Rejection, mailed

January 24, 2007. The Appellants filed an Appeal Brief in support of the

appeal on May 15, 2007. An Examiner's Answer to the Appeal Brief was

mailed on September 5, 2007. A Reply Brief was filed on October 19, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

| Bayer | US 6,311,190 B1 | Oct. 30, 2001 |
| Herz | US 6,460,036 B1 | Oct. 1, 2002 |

REJECTIONS

Claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 stand rejected under 35 U.S.C.

§ 103(a) as unpatentable over Herz.

Claims 3, 5, 11, 13, 19, and 21 stand rejected under 35 U.S.C. §

103(a) as unpatentable over Herz.

Claims 6, 7, 14, 15, 22, and 23 stand rejected under 35 U.S.C. §

103(a) as unpatentable over Herz and Bayer.

1   ISSUES

2   The issues pertinent to this appeal are

3   • Whether the Appellants have sustained their burden of showing that

4   the Examiner erred in rejecting claims 1, 4, 8, 9, 12, 16, 17, 20, and 24

5   under 35 U.S.C. § 103(a) as unpatentable over Herz.

6   • Whether the Appellants have sustained their burden of showing that

7   the Examiner erred in rejecting claims 3, 5, 11, 13, 19, and 21 under

8   35 U.S.C. § 103(a) as unpatentable over Herz.

9   • Whether the Appellants have sustained their burden of showing that

10   the Examiner erred in rejecting claims 6, 7, 14, 15, 22, and 23 under

11   35 U.S.C. § 103(a) as unpatentable over Herz and Bayer.

12   The pertinent issues turn on whether Herz describes limitation [2] of

13 claims 1, 6, and 17.

14

15   FACTS PERTINENT TO THE ISSUES

16   The following enumerated Findings of Fact (FF) are believed to be

17 supported by a preponderance of the evidence.

18   *Herz*

19   01.   Herz is directed towards a system and method for identifying

20   objects in an electronic media environment (column 1, lines 19-

21   20). Herz describes the search for objects using both a frequency

22   of terms of interest value and a user feedback value representing

23   the user's interest in the retrieved object (column 5, lines 7-22).

24   02.   Users are presented with target objects and users are polled to

25   determine their interest in the target object (column 17, lines 29-

26   50). For example, the users are presented with news clippings and

1   polled for their interest in the presented articles (column 18, lines

2   37-40). The user then submits active or passive feedback to the

3   system regarding their interest in the object (column 18, lines 37-

4   40).

5   03.   Herz describes a proxy server that services a set of users (a user

6   base). The proxy server provides a solution to privacy issues by

7   serving as the intermediary between the information provider and

8   the user (column 5, lines 50-53). The proxy server disassociates

9   the identity of the user from the pseudonym by using

10   cryptographic techniques (column 5, lines 53-55). The proxy

11   server also permits access to target objects or user profiles

12   (column 5, lines 55-60). The proxy server provides three

13   functions to the user: bidirectional transfer of communications,

14   recording of user-specific information, and as a selective

15   forwarding agent. The function of selectively forwarding

16   communications involves following access control functions to

17   determine which communications to forward to the user and

18   which to reject (column 32, lines 19-67).

19   04.   Herz describes that the proxy server is used to protect the user

20   from inappropriate or misrepresented target objects. This includes

21   solicited as well as unsolicited transmissions. Furthermore, the

22   proxy server enables parents to implement parental controls that

23   prevent a child from accessing pornographic websites (column 48,

24   lines 9-29).

25   05.   Messages that are undesirable to the user or messages from an

26   undesirable source are filtered (column 63, lines 50-54). The

1   filtered mail is either deleted or ignored (column 63, line 48). The

2   email filtering system processes received emails to automate

3   actions that need to be taken by the user (column 63, lines 1-19).

4 *Bayer*

5   06. Bayer is directed to a system and method for conducting

6   surveys in different languages.

7   07. Bayer is concerned with providing the users the results of the

8   vote because the users may be the most interested in how their

9   votes compare to others (column 1, lines 35-40).

10   08. Bayer describes tallying the totals for each response or vote by

11   adding the answer to records in the database (column 3, lines 7-

12   10).

13 *Facts Related To The Level Of Skill In The Art*

14   09. Neither the Examiner nor the Appellants have addressed the

15   level of ordinary skill in the pertinent arts of electronic voting.

16   We will therefore consider the cited prior art as representative of

17   the level of ordinary skill in the art. *See Okajima v. Bourdeau*,

18   261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific

19   findings on the level of skill in the art does not give rise to

20   reversible error 'where the prior art itself reflects an appropriate

21   level and a need for testimony is not shown'") (quoting *Litton*

22   *Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163

23   (Fed. Cir. 1985)).

24 *Facts Related To Secondary Considerations*

25   10. There is no evidence on record of secondary considerations of

26   non-obviousness for our consideration.

1

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR Int'l v. Teleflex Inc.*, 127 S. Ct. at 1734. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, at 1739.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id*. at 1740.

"For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id*.

1   "Under the correct analysis, any need or problem known in the field

2   of endeavor at the time of invention and addressed by the patent can provide

3   a reason for combining the elements in the manner claimed." *Id.* at 1742.

4

5   ANALYSIS

6   *Claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 rejected under 35 U.S.C. §*

7   *103(a) as unpatentable over Herz*

8   The Appellants argue these claims as a group.

9   Accordingly, we select claim 1 as representative of the group.

10   37 C.F.R. § 41.37(c)(1)(vii) (2007).

11   The Examiner found that Herz describes all of the limitations of claim

12   1 (Answer Pages 4-5) except for limitation [6]. The Examiner took Official

13   Notice that the practice of disregarding an unauthorized message or

14   communication is old and well-known in the art (Answer Page 6). The

15   Examiner then found that one of ordinary skill in the art would have known

16   to modify Herz to include the providing for pre-authorization of users and

17   validating the identify before forwarding their electronic voting message to

18   include this feature disregarding an unauthorized message in order to

19   increase security by preventing abuse of the system (Answer Page 6).

20   The Appellants contend that (1) Herz fails to describe limitation [1] of

21   claims 1, 9, and 17 (Br. Page 9, first paragraph), (2) Herz fails to describe

22   limitation [2] of claims 1, 9, and 17 (Br. Page 10, last paragraph), (3) Herz

23   fails to describe limitation [4] of claims 1, 9, and 17 (Br. Page 11, last

24   paragraph), (4) Herz fails to describe limitation [5] of claims 1, 9, and 17

25   (Br. Page 12, first paragraph), and (5) Herz fails to describe limitation [6] of

26   claims 1, 9, and 17 (Br. Page 14, third paragraph).

1   We find that the Appellants' second argument is determinative. The

2   Appellants contend (2) Herz fails to describe limitation [2] of claim 1 (Br.

3   Page 10, last paragraph). We agree with the Appellants. Limitation [2]

4   recites sending the voter list to the mail forwarding service, which in turn

5   forwards the vote requests to the authorized voters.

6   The Examiner referred to two independent processes in Herz and

7   found them to be part of a single process. The first process in Herz the

8   Examiner cited to is that of making the user profiles available for sale to

9   marketers (the voter data list) (Answer Page 12). This list of user profiles is

10   part of the feedback process (voting process) used for searching, which is

11   associated with the user profiles as preferences (FF 02). The second process

12   the Examiner referred to is the email filtering system (FF 05). The email

13   filtering system provided by Herz is for receiving emails and processing the

14   emails such that undesirable emails are discarded (FF 05).

15   The emailing filtering system is independent of the object search

16   system that uses the users' feedback. As such, the Examiner equated two

17   independent processes in Herz to a single process in the claimed limitation

18   [2]. Thus, the Examiner erred by finding that Herz describes the limitation

19   of "sending the voter data list to a mail forwarding service, wherein the mail

20   forwarding service sends one or more vote requests to one or more of the

21   plurality of authorized voters." Because the Appellants' second argument is

22   determinative, we need not reach the remaining arguments.

23   The Appellants have sustained their burden of showing that the

24   Examiner erred in rejecting claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 under 35

25   U.S.C. § 103(a) as unpatentable over Herz for the above reasons.

1   *Claims 3, 5, 11, 13, 19, and 21 rejected under 35 U.S.C. § 103(a) as*

2   *unpatentable over Herz*

3   The Appellants argue these claims as a group.

4   Accordingly, we select claim 3 as representative of the group.

5   37 C.F.R. § 41.37(c)(1)(vii) (2007).

6   The Examiner found that Herz described all of the limitations of claim

7   3 except for "sending a confirmation message to the client, the confirmation

8   message including a summary of the determination" (Answer Page 8). The

9   Examiner found that it was old and well-known in the art provide

10   confirmation messages regarding a summary of a determination and that one

11   of ordinary skill in the art would have known to modify Herz to include this

12   feature in order to provide a user with assurance that their feedback was

13   received (Answer Page 8).

14   The Appellants contend that (1) dependant claims 3, 5, 11, 13, 19, and

15   21 were improperly rejected for the same reasons discussed above for

16   independent claims 1, 9, and 17 (Br. Page 15, first paragraph), (2) Herz fails

17   to describe "sending a confirmation message to the client, the confirmation

18   message including a summary of the determination" as per claims 3, 11, and

19   19 (Br. Page 15, second paragraph), and (3) Herz fails to describe "one of

20   the votes includes a freeform comment" as per claims 5, 13, and 21 (Br.

21   Page 15, last paragraph).

22   The Appellants first contend (1) dependant claims 3, 5, 11, 13, 19, and

23   21 were improperly rejected for the same reasons discussed above for

24   independent claims 1, 9, and 17 (Br. Page 15, first paragraph). We agree

25   with the Appellants. The Appellants rely on their arguments in support of

26   claims 1, 6, and 17 above, which we found to be sufficient to overcome the

1   Appellants' burden and so have similarly sustained their burden of showing

2   that the Examiner erred in rejecting claims 3, 5, 11, 13, 19, and 21 under 35

3   U.S.C. § 103(a) as unpatentable over Herz.

4

5   *Claims 6, 7, 14, 15, 22, and 23 rejected under 35 U.S.C. § 103(a) as*

6   *unpatentable over Herz and Bayer*

7   The Appellants argue these claims as a group.

8   Accordingly, we select claim 6 as representative of the group.

9   37 C.F.R. § 41.37(c)(1)(vii) (2007).

10   The Examiner found that Herz described all of the limitations of claim

11   6 except "modifying a total number of votes, the modifying further

12   including: adding the one or more votes to the total number of votes"

13   (Answer Page 10). The Examiner found that Bayer described this limitation

14   and that one of ordinary skill in the art would have known to combine Herz

15   and Bayer in order to increase user satisfaction (Answer Pages 10-11).

16   The Appellants contend that (1) dependant claims 6, 7, 14, 15, 22, and

17   23 were improperly rejected for the same reasons discussed above for

18   independent claims 1, 9, and 17 (Br. Page 16, third paragraph) and (2) Bayer

19   fails to cure the deficiencies in Herz described above (Br. Page 16, third

20   paragraph).

21   The Appellants contend (1) dependant claims 6, 7, 14, 15, 22, and 23

22   were improperly rejected for the same reasons discussed above for

23   independent claims 1, 9, and 17 (Br. Page 16, third paragraph). We agree

24   with the Appellants. The Appellants rely on their arguments in support of

25   claims 1, 6, and 17 above, which we found to be sufficient to overcome the

26   Appellants' burden, and so have similarly sustained their burden of showing

11

1   that the Examiner erred in rejecting claims 3, 5, 11, 13, 19, and 21 under 35

2   U.S.C. § 103(a) as unpatentable over Herz and Bayer.

3

4   CONCLUSIONS OF LAW

5   The Appellants have sustained their burden of showing that the

6   Examiner erred in rejecting claims 1, 3-9, 11-17, and 19-24 under

7   35 U.S.C. § 103(a) as unpatentable over the prior art.

8

9   DECISION

10   To summarize, our decision is as follows:

11 •   The rejection of claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 under 35

12   U.S.C. § 103(a) as unpatentable over Herz is not sustained.

13 •   The rejection of claims 3, 5, 11, 13, 19, and 21 under 35 U.S.C. §

14   103(a) as unpatentable over Herz is not sustained.

15 •   The rejection of claims 6, 7, 14, 15, 22, and 23 under 35 U.S.C. §

16   103(a) as unpatentable over Herz and Bayer is not sustained.

17

18   <u>REVERSED</u>
19
20
21
22

23

24

25

26

27

28

1

2

3

4

5

6

7   LV:

8
9
10
11
12   IBM CORPORATION – AUSTIN (JVL)
13   C/O VAN LEEUWEN & VAN LEEUWEN
14   P.O. BOX 90609
15   AUSTIN, TX 78709-0609